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| 10/810,671 | 03/29/2004 | Veronika Hochstein | MERCK-2867 | 1160 |
| 23599 7590 12/20/2006 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | EXAMINER KOSLOW, CAROL M | |
| | | | ART UNIT 1755 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 12/20/2006 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/810,671

Applicant(s)

HOCHSTEIN ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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This action is in response to applicants' amendment of 22 November 2006. The amendments to the claims have overcome the 35 USC 102 rejections Applicants' arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The added proviso is new matter. There is no explicit disclosure of the proviso, no explicit disclosure of a glass flake containing alternating layers of TiO₂, SiO₂ and TiO₂ and *Ex parte Parks*, 30 (USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) is not applicable. See MPEP 2173.05(i).

Applicants' arguments have been considered but are not convincing. Applicants' argue that the excluded embodiment is clearly disclosed within the statement "glass flakes coated with one of more metal oxides". While the statement supports this embodiment for the purpose of the 35 USC 112 written description requirement, This phrase do not positively recite the embodiment in the excluding proviso. The requirement for an excluding proviso is that the excluded embodiment must be positively recited in the specification, as discussed in MPEP 2173.05(i). This generic statement does not positively recite a glass flake containing alternating layers of TiO₂, SiO₂ and TiO₂. The section of *In re Johnson*, 194 USPQ 187 (CCPA 1977) cited by applicants is addressing situations where positively recited species are excluded. This is not the situation here where applicants are excluding an unrecited species. Applicants' characterization of *Ex parte Parks*, 30 (USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) is

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incorrect. In that case, an excluding proviso was added to exclude a gas from an atmosphere where it was clear from the specification that the claimed atmosphere would include the excluded gas. Thus if *Ex parte Parks*, 30 (USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) is applicable, then *In re Johnson*, 194 USPQ 187 (CCPA 1977) could not be applicable and vice versa. The rejection is maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 16 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6 and 8 of U.S. Patent No. 6,517,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pigment mixture claimed in the patent includes the claimed pigment mixture. The patented mixture comprises component B, which can be the B pigments claimed in this application and component A, which can have a glass substrate. The glass substrate based A pigments reads

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upon the A pigments of this application. The patented claims teach a cosmetic and a food product comprises the patented pigment mixture. The patented weight ratio of A to B falls within the claimed range.

Applicants' arguments are not convincing since claim 1, and thus claim 12, clearly teaches an embodiment where component A is a glass flake coated with two or more metal oxide layers, including at least one layer of a high refractive index oxide is adjacent to a low refractive index oxide. This is because claim 1 includes glass flake as one of the members of the Markush group. The argued case law is not applicable since the claims clearly disclose a glass flake coated with two or more metal oxide layers, including at least one layer of a high refractive index oxide is adjacent to a low refractive index oxide. The rejection is maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/90448.

Page 6, line 33 through page 7, line 2 of this reference teaches a mixture of an effect pigment based on glass flakes and any of the listed pigments, which includes inorganic flake form pigment, luster pigments, which are interference pigments, and inorganic crystalline pigments, which are different from the taught glass based pigments. It is clear from the rest of the reference that the glass flake does not contain alternating layers of TiO_2 , SiO_2 and TiO_2 . One of ordinary skill in the art would have found it obvious to use any of the specified pigments on pages 4-6 as the pigment which is blended with the listed pigments on page 6, line 33 through page 7, line 2, such as the disclosed luster, or interference, pigments, which are multi-layered

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pigments. This list includes the claimed pigments of glass flake+TiO₂ layer, glass flake+Fe₂O₃ layer, glass flake+Fe₃O₄ layer, glass flake+TiFe₂O₃ layer and glass flake+Cr₂O₃ layer. The weight ratio of the suggested blend is greater than 0: less than 100 to less than 100:greater than 0. This range encompasses the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The taught glass flakes have a thickness of 0.1-0.5 micron, which falls within the claimed range. Page 7, lines 4-6 and page 8, lines 1-9 teach the pigment mixtures can contain wetting agents, dispersing agents, water and at least one organic solvent. All of these compounds are additives which are conventional in cosmetics. The reference suggests the claimed pigment mixture.

Applicants argue there is no specific embodiment to the claimed mixture. The taught admixture on pages 6 and 7 teaches the mixture of claim 1 and suggests the mixtures of claims 2-5 and 7-10 for the reasons discussed above. The arguments with respect to specific mixtures is not convincing since the claims are not directed to any specific mixtures, but are to a generic mixture of component A, a glass flake based effect pigment, and component B, which is selected from the group consisting of organic and inorganic flake-form, needle shaped, spherical or crystalline colorants and/or colorants. The argued case law is not applicable since the cited cases are directed organic compounds where the genus is a formula and the species are specific compounds which fall within the formula. They do not address the present situation where the reference teaches a mixture of A and B, where A and B are each selected from a list of

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materials. While the examples do not teach the claimed mixtures, a reference is good for all teaches and is not limited to the teachings in the examples. The rejection is maintained.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/6554.

Page 14, line 31 through page 15, line 2 of this reference teaches a mixture of an effect pigment based on glass flakes and any of the listed pigments, which includes inorganic flake form pigment and inorganic crystalline pigments, which are different from the taught glass based pigments. One of ordinary skill in the art would have found it obvious to use any of the specified pigments on pages 9-10 as the pigment which is blended with the listed pigments on page 14, line 31 through page 15, line 2, such as the disclosed luster, or interference, pigments, which are multi-layered pigments. This list on page 9-10 includes several of the claimed pigments. The weight ratio of the suggested blend is greater than 0: less than 100 to less than 100:greater than 0. This range encompasses the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The taught glass flakes have a thickness of 0.1-0.8 micron, which falls within the claimed range. Page 15, lines 9-12 teach the pigment mixtures can contain wetting agents, dispersing agents, water and at least one organic solvent. All of these compounds are additives which are conventional in cosmetics. The reference suggests the claimed pigment mixture.

Applicants argue there is no specific embodiment to the claimed mixture. The mixtures on pages 14 and 15 teach the mixture of claim 1 and suggest the mixtures of claims 2-5 and 7-10

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for the reasons discussed above. The arguments with respect to specific mixtures is not convincing since the claims are not directed to any specific mixtures, but are to a generic mixture of component A, a glass flake based effect pigment, and component B, which is selected from the group consisting of organic and inorganic flake-form, needle shaped, spherical or crystalline colorants and/or colorants. The argued case law is not applicable since the cited cases are directed organic compounds where the genus is a formula and the species are specific compounds which fall within the formula. They do not address the present situation where the reference teaches a mixture of A and B, where A and B are each selected from a list of materials. While the examples do not teach the claimed mixtures, a reference is good for all teaches and is not limited to the teachings in the examples. The rejection is maintained.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,517,628.

This reference teaches a pigment mixture and the use of this mixture to color cosmetics and medicament coatings (col. 3, lines 50-53). Thus the reference teaches cosmetics containing the pigment mixture and at least one cosmetically suitable additive, a pharmaceutical composition comprising the pigment mixture and at least one pharmaceutical medicament. Column 3, lines 50-53 also using the pigment mixture as a food coloring, which means it would have been obvious to use it in the same applications, as conventional food colorings, such as in icings. Thus the claimed food finishing composition is suggested. The pigment mixture comprises component A, which is a multilayered effect pigment where the substrate can be glass flakes and component B, which comprise flaky, acicular or spherical colorants and/or fillers. The weight ratio of A to B is 1:10 to 10:1, which falls within the claimed range. Column 2, lines 30-

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35 teach the preferred layer structure of the pigment of component A. When the substrate is a glass flake, then several of the pigments of claims 3 and 4 are suggested. The thickness of the substrate of component A is 0.4-2 microns, which overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Column 3, lines 4-24 and 30-35 teaches the pigment of the B component is a pearlescent/interference pigment, a multilayered OVP pigment or a holographic pigment. Example 4 and 7 show that the taught pigment mixture can also contain at least one additive which is conventional in cosmetics. The reference suggests the claimed pigment mixture, cosmetic, food finishing composition and pharmaceutical composition.

Applicants' arguments are not convincing since the reference clearly teaches an embodiment where component A is a glass flake coated with two or more metal oxide layers, including at least one layer of a high refractive index oxide is adjacent to a low refractive index oxide. The glass flake is one of the members of the Markush group for component A discussed throughout the specification and thus is disclosed. The argued case law is not applicable since the claims clearly disclose a glass flake coated with two or more metal oxide layers, including at least one layer of a high refractive index oxide is adjacent to a low refractive index oxide. While the examples do not teach glass flakes, a reference is good for all teaches and is not limited to the teachings in the examples. The rejection is maintained.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

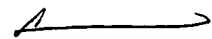
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
December 19, 2006


C. Melissa Koslow
Primary Examiner
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